

REMARKS

Applicant appreciates the indication in the Office Action dated 6 June 2009 (the "Final Office Action") that claim 11 is directed to allowable subject matter. However, Applicant submits that the present rejections of claims 1-9 are improper, as the teachings of Grunsted (US 6,192,123) and Pernu (US 6,978,005) do not anticipate or suggest the present invention. Accordingly, Applicant respectfully requests reconsideration of the pending claims in view of the comments below.

Claim Rejections – 35 USC § 112

Claims 1-9 and 11 are apparently rejected as under 35 U.S.C. § 112 for alleged indefiniteness. The Final Office Action complains that claims 1-9 and 11 recite the limitation "the corresponding type," alleging that there is insufficient basis for this limitation in the claim. This rejection is improper, as the scope of the claim is not indeterminate or otherwise indefinite.

The Manual for Patent Examining Procedure (MPEP) is quite clear that a claim is indefinite if it contains words or phrases whose meaning is unclear. (MPEP § 2173.05(e).) A lack of clarity might arise if a claim term is recited in such a manner that suggests an antecedent in the claim, but such antecedent is in fact lacking. But, the MPEP also points out that "[o]bviously, however, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite." (*Id.*) The MPEP continues by explaining the proper test: "If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite." (*Id.*) Thus, it is not proper to mechanically reject a claim simply because it uses the word "the" or "said" before a claim feature, when that claim feature is not explicitly recited earlier in the claim. Indeed, the MPEP says that the form paragraph used in the Final Office Action "should ONLY be used in aggravated situations where the lack of antecedent basis makes the scope of the claim indeterminate." (MPEP 706.03(d).)

In the present case, the preamble of claim 1 recites "a first telecommunications network having first subscribers with autonomous type terminals and second subscribers with network type terminals." The body of the claim recites "associating each of the first and second subscribers with the corresponding type of terminal." (Emphasis added.) From the preamble, a reader of the claim already knows that each of the first subscribers has a terminal of the autonomous type, and that each of the second subscribers has a terminal of the network type. One of ordinary skill in the art would have no trouble ascertaining that the "associating" feature of the claim is directed to a step of associating each subscriber with the terminal type that corresponds to the subscriber. Because it has already been established that there is a first correspondence between the first subscribers and terminals of the autonomous type and a second correspondence between second subscribers and terminals of the network type, there is a clear implicit antecedent for the phrase "the corresponding type." The Applicant thus respectfully requests that the rejections under 35 U.S.C. § 112 be withdrawn.

Claim Rejections – 35 USC § 103

Claims 1-9 stand rejected under the Final Office Action as allegedly obvious over Grunsted in view of Pernu. These rejections are improper, as the combined teachings of Grunsted and Pernu do not anticipate or suggest the claimed invention. Indeed, while the Final Office Action relies primarily on Grunsted for finding the features of the claimed invention, several of these features are utterly absent from Grunsted, which does not resemble the claimed invention at all. These absences are not cured by the limited teachings of Pernu.

Claim 1 is directed to a method of providing data objects to terminals of subscribers in a first telecommunications network, where the telecommunication network has first subscribers having autonomous type terminals and second subscribers having network type terminals. The claim preamble defines autonomous type terminals as those that comprise function for client-

based retrieval of data objects and network type terminals rely on functionality in the telecommunications network to provide for retrieval of data objects. Thus, an autonomous type terminal can retrieve a data object by "pulling" the data object, while a network type terminal relies on the network to "push" the data object to it.

The body of claim 1 recites three features: (1) associating each of the first and second subscribers with the corresponding type of terminal; (2) determining occurrences of triggering events indicating communication events between subscribers; and (3) upon determination of each triggering event, selectively providing data object retrieval only to subscribers associated with network type terminals. Thus, a service in a telecommunications network detects the occurrence of a particular triggering event that indicates a particular communication event between two or more subscribers. If a given subscriber involved in the communication event is associated with a network type terminal, then that subscriber's terminal needs "help" in retrieving a data object associated with the communications event. On the other hand, if a given subscriber involved in the communication event is associated with an autonomous type terminal, that subscriber's terminal is capable of retrieving the data object using a client-based retrieval approach. Accordingly, the network service selectively provides data object retrieval only to subscribers associated with network type terminals.

Grunsted fails to disclose numerous features of claim 1. The techniques disclosed in Grunsted, even in view of the teachings of Pernu, do not resemble the claimed method at all. The differences are many, and include at least the following:

1. Grunsted does not disclose or suggest a telecommunications network having subscribers with autonomous type terminals and subscribers with network type terminals. Rather, Grunsted discloses a data communications network, i.e., the Internet, having a number of associated computer terminals with browsing functionality. (Grunsted col. 3, lines 59-64,

describing Internet 120 and computers 110a-d.) Grunsted also discloses a telecommunications network, i.e., a public switched telephone network, having a number of associated conventional telephones. (Grunsted, col. 3, line 65-col. 4, line 2.) The focus of Grunsted's disclosure is a "telephone service system 130 [that] connects the Internet to a public switched telephone network..." (Grunsted, col. 3, lines 65-66.) Thus, Grunsted describes a sort of "bridge" or "gateway" between a data communications network and a telecommunications network. Grunsted's computers reside in the data communications network, and do not operate in the public switched telephone network. Grunsted's telephones reside in the telecommunications network, and do not operate in the data communications network. Grunsted does not disclose or suggest a telecommunications network supporting two distinct types of terminals.

2. Grunsted does not disclose autonomous type terminals in a telecommunications network. The Final Office Action points to Grunsted's "multiple telephones" as corresponding to the claimed autonomous type terminals, but then acknowledges that Grunsted's telephones do not comprise functionality for client-based retrieval of data objects. (Final Office Action, p. 3.) The Final Office Action then asserts that Pernu does disclose such terminals, and argues that it would have been obvious to modify Grunsted to include Pernu's ISDN terminals, which are capable of retrieving telephone book information. If the Final Office Action's arguments are accepted, then the combination of Grunsted with Pernu discloses (1) a data communications network (i.e., the Internet) having conventional computers attached, (2) a telecommunications network having autonomous type network terminals attached, and (3) a "telephone service system" that resides between these two networks.

3. Grunsted does not disclose network type terminals in a telecommunications network. The Final Office points to Grunsted's "multiple computers" as corresponding to the recited network type terminals. However, as noted above, these computers do not operate in a telecommunications network, and thus cannot correspond to the recited "telecommunications

network having ... second subscribers with network type terminals." Furthermore, Grunsted's computers are clearly capable of retrieving data objects on their own, as they are described as including conventional web browsers which may be utilized to retrieve web pages selected by the web browser. (Grunsted col. 4, lines 34-42.) Thus, Grunsted's computers clearly do not rely on functionality in the telecommunications network to provide for retrieval of data objects, as opposed to comprising functionality for client-based retrieval of data objects. Indeed, Grunsted's web browsers are the epitome of client-based retrieval of data objects.

4. Grunsted does not disclose associating each of the first and second subscribers with the corresponding type of terminal. The Final Office Action's several citations to Grunsted provide no support for the Office Action's assertion that this feature is disclosed therein. The first citation, to Grunsted's col. 4, lines 2-4, is to a sentence that simply states that Grunsted's "Internet users on computers 110 transmit service requests over the Internet to system 130 that in turn processes the requests accordingly." Likewise, the second citation, to col. 5, lines 29-62, is to a more detailed description of a transaction in which a user operates a web browser to submit a "Call Me" request to a server, and receives a web page in response. The cited section further describes a sequence of events in which the web server retrieves account information for the user, and signals a telephone switch to call the user via the user's separate telephone equipment. None of this appears to have anything to do with the claimed "associating each of the first and second subscribers with the corresponding type of terminal." The remaining citations are of no further help in supporting the Office Action's finding.

5. Grunsted does not disclose "selectively providing data object retrieval only to subscribers associated with network type terminals," as claimed. The Final Office Action again alleges that Grunsted's computers correspond to the claimed "network type terminals." As discussed above, Grunsted's computers are not terminals in a telecommunications network at all, and are further not "network type terminals" as defined expressly in the claim, since

Grunsted's computers are equipped with client-based functionality for retrieving data objects (i.e., a web browser). Thus, it makes no sense to assert that Grunsted teaches "selectively provides data object retrieval only to subscribers associated with network type terminals." In fact, Grunsted is not selective at all – its web server provides web pages to every subscriber that initiates a "call me" request. (See Grunsted col. 5, line 29 – col. 6, line 15.)

The combination of Grunsted with Pernu does not cure Grunsted's omissions. As discussed above, Grunsted fails to disclose numerous features of claim 1. The addition of the teachings of Pernu does not render claim 1 obvious. At best, Pernu teaches that Grunsted's conventional telephones may be replaced with ISDN telephones that are capable of receiving telephone book information autonomously. However, this does nothing to correct the fact that neither Grunsted nor Pernu, alone or in combination, discloses or suggests a process in which subscribers are associated with a terminal type corresponding to the type of terminal that they have and in which data object retrieval is provided selectively only to subscribers associated with network type terminals. Indeed, the Final Office Action does not allege that Pernu teaches "associating each of the first and second subscribers with the corresponding type of terminal." The Final Office Action does not allege that Pernu teaches "selectively providing data object retrieval only to subscribers associated with network type terminals." Since these features are clearly not taught in Grunsted, the Final Office Action has failed to explain why the differences between the prior art, considered as a whole, and the claimed invention would have been obvious to one of ordinary skill in the art. Accordingly, the Final Office Action fails to establish a proper *prima facie* case of obviousness, and the pending rejections of claim 1 and its dependent claims 2-8 should be withdrawn. Because independent claim 9 includes several features that are similar to those of claim 1, and that are also absent from the teachings of Grunsted and Pernu, considered as a whole, the rejection of claim 9 is also improper and should be withdrawn.

The rejections of several dependent claims are improper for additional reasons. As a group, the dependent claim rejections are improper for the reasons given above. However, features specific to several of the dependent claims are also absent from Grunsted and Pernu, and would not have been obvious to one of ordinary skill in the art in view of those references. The rejections of these dependent claims should be withdrawn for these additional reasons.

For instance, claim 2 recites "associating a terminal capability with at least one of the second subscribers," and "providing data retrieval in view of the associated terminal capabilities." This feature is distinct from the "associating each of the first and second subscribers with the corresponding type of terminal" of claim 1. As the specification explains that some terminals may be capable of displaying graphics while others may be text only, for example. (Specification, p. 13, lines 13-18.) Thus, the data object retrieval is provided in view of those capabilities, e.g., a data object may need to be adapted to match the capabilities. Neither Grunsted nor Pernu discloses or suggests this feature. In particular, neither discloses that a particular terminal capability is associated with a subscriber.

Claim 3 recites "determining whether a subscriber involved in a first communication event belongs to a second network and, if the subscriber belongs to the second network, then selectively letting the second network provide data object retrieval to the subscriber based on whether the second network provides data object retrieval for network type terminals." This feature is not disclosed or suggested in the cited references, and the Final Office Action's citations are of no avail. Neither reference discloses such a technique. In particular, neither reference discloses or suggests such a "determining" step, and neither discloses or suggests a process in which a decision to selectively let a second network provide data object retrieval is based on whether the second network provides data object retrieval for network type terminals." The Final Office Action again attempts to analogize Grunsted's computers with the network type

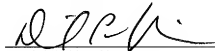
terminals – again this is incorrect. In any event, Grunsted's server does not make the determination recited in the claim, and does not selectively let a separate network provide data object retrieval based on a determination of whether such network provides data object retrieval for network type terminals. A similar analysis applies to claim 4, which is also improperly rejected.

Conclusion

For the reasons given above, the rejections of claims 1-9 and 11 are improper, and should be withdrawn. Reconsideration of the application and allowance of the claims is thus respectfully requested.

Respectfully submitted,

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